

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Through this Reply, claims 21-28 have been added. Therefore, claims 1-28 remain pending. Claims 1, 7, 8, and 14 are independent.

SCOPE OF CLAIMS NOT ALTERED

Claim 19 has been amended merely to address an informal issue. It is intended that the scope of the claim remain the same.

ALLOWABLE SUBJECT MATTER

Applicants appreciate that claims 3, 10, and 20 are indicated to define allowable subject matter.

§ 103 REJECTION – TANAKA, ENOMOTO, JACOBSEN, UEDA

Claims 1, 2, 4-9, and 11-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka et al. (U.S. Patent No. 6,577,338, hereinafter “Tanaka”) in view of Enomoto (JP 10-096619), in further view of Jacobsen et al. (USPN 6,677,936, hereinafter “Jacobsen”), and in further view of Ueda et al. (U.S. Patent No. 5,748,237, hereinafter “Ueda”). *See September 9th Office Action, page 3, item 1 and page 15, item 17.* Applicants respectfully traverse.

Applicants maintain all patentability arguments made in response to prior Office Actions from the Examiner. In addition, for a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish a *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P. 2142*; *M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In the September 9th Office Action, the Examiner admits that Tanaka cannot be relied upon to teach or suggest the feature of “in a case in which the designating device does not further designate switching of the image even after a predetermined amount of time has elapsed from the time the image was switched to or from the time the auxiliary lamp was lit, the control device turns off the auxiliary lamp” as recited in independent claim 1. See *September 9th Office Action, page 3, lines 15-19*. Independent claims 7, 8, and 14 recite similar features. However, the Examiner asserts that Enomoto teaches such a feature. See *September 9th Office Action, page 3, line 20 – page 4, line 3*.

Contrary to Examiner’s assertion, Enomoto cannot be relied upon to teach or suggest this feature. Enomoto merely states that the power control means switches the power supply to the monitor to a power-saving state (off state) if the control unit is not operated for a set amount of time. See

paragraph [0005]. Enomoto is silent regarding other conditions in which the power supply to the monitor is cut off. Thus, at best, Enomoto only suggests that whether or not a **user** operates the device within a prescribed amount of time is considered when determining whether to turn the power off. Enomoto cannot be relied upon for turning off the auxiliary lamp “in a case in which the designating device does not further designate switching of the image even after a predetermined amount of time has elapsed from the time the image was switched to or from the time the auxiliary lamp was lit” as recited in the independent claims.

Another requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited references to modify the reference(s) as proposed in the Office Action. *See M.P.E.P. 2143.01*. The cited reference must be considered in its entirety including disclosures that teach away from the claimed invention. *See M.P.E.P. 2141.02*. If the cited reference(s) teach away from the claimed invention, then the combination is improper and the rejection must fail.

In this instance, even if it is unreasonably assumed that Enomoto teaches or suggests the feature as recited above, Tanaka and Enomoto cannot be properly be combined because Tanaka specifically teaches away from this feature. Tanaka specifically indicates that the power of the camera turning off is a problem. Tanaka states, “it sometimes happens that the camera may be

provided with a function of turning off the power source to suppress the consumption of the battery when the digital camera is not operated for a predetermined time. In such a case, there may be a **disadvantage** in that the power source of the digital camera is automatically turned off despite the fact that ... the image data are not transmitted from the digital camera ... and the printing cannot be completely carried out as a result.” *Emphasis added; see column 2, lines 28-40.*

Tanaka also states, “a communication to the digital camera 101 is performed regularly ... thereby **preventing an automatic OFF** of the power source.” *Emphasis added; see column 7, lines 23-28.* Clearly, Tanaka cannot have the camera go into a power off mode, which is completely antithetical to and teaches away from Enomoto (to the extent that Enomoto is even assumed to teach the feature recited above) as well as from the above-recited feature. Therefore, Tanaka cannot be properly combined with Enomoto and the rejection based on a combination of Tanaka and Enomoto is improper.

Jacobsen and Ueda have not been, and indeed cannot be, relied upon to correct for at least this deficiency. Therefore, the independent claims are distinguishable over the combination of Tanaka, Enomoto, Jacobsen, and Ueda.

Also, Applicants demonstrated that it is unreasonable for the Examiner to assert the display of frames as disclosed in Jacobsen to be equivalent to the display of images as claimed. *See Rule 116 Reply filed on April 28, 2004, pages*

16-17. It was shown that Jacobsen makes a clear distinction between **images** and **frames**. In Jacobsen, an image may be displayed as multiple frames. The frames are scanned to the display very rapidly in succession to display the image. For example, Jacobsen states, "In order to reduce flicker it is desirable to drive the active matrix at 180 Hz to produce a 60 Hz color image." See *Jacobsen*, column 1, line 66 – column 2, line 2. In other words, **60 frames** should be displayed in one second to reduce flicker when displaying an image. Jacobsen also states, "When the display is used to display text, wherein the image display is not constantly changing, a feature ... is to reduce the frame rate." Again, this strongly indicates that Jacobsen distinguishes the display of images from frames.

In response, the Examiner merely asserts that "the frames of image data in Jacobsen are frames of image data for motion video" without providing any support in Jacobsen to even infer such a feature is taught. Clearly, it is unreasonable for the Examiner to merely assert a fact without providing any support.

The Examiner also relied upon column 10, lines 48-55 to allegedly provide the motivation to power down the back-light to the display, to supposedly lengthen the battery power. See *September 9th Office Action*, page 2, lines 14-18. More specifically, it appears that Jacobsen's statement "Thus, after a frame of data is written on the display, power is lowered until the next

frame is written. This lengthens battery cycle time of portable communication devices” has been interpreted by the Examiner to mean that the power to the back-light is turned off in between frames. Closer inspection reveals the Examiner’s misunderstanding.

In Jacobsen, it is indicated that the thin film active matrix – which is the display - has the ability to store charges between vertical synchronization pulses. *See column 10, lines 43-45.* Because the display has the ability to store charges, the power to the display need not be constantly applied to maintain the information within the display. As such, the power applied to the display can be turned off intermittently to save battery power, for example, after a frame is written.

Thus, Jacobsen’s statement actually refers to the power applied to the display itself. The statement cannot be applied to the back-light that lights the display. Indeed, the back-light must be on to view the display, regardless of whether or not the power to the display is applied. Clearly then, the Examiner’s reliance on column 10, lines 48-55 of Jacobsen to provide the motivation to power down the back-light is misguided.

For at least the reasons stated above, independent claims 1, 7, 8, and 14 are distinguishable over the combination of Tanaka, Enomoto, Jacobsen, and Ueda. Claims 2, 4-6, 9, 11-13, and 15-19 depend from independent claims 1, 8, or 14 directly or indirectly. Therefore, for at least the reasons stated with

respect to the independent claims 1, 8, or 14 as well as on their own merits, these dependent claims are also distinguishable over the combination of Tanaka, Enomoto, Jacobsen, and Ueda.

Applicants respectfully that the rejection of claims 1, 2, 4-9, and 11-19 based on Tanaka, Enomoto, Jacobsen, and Ueda be withdrawn.

NEW CLAIMS

Claims 21-28 have been added through this Reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. It is noted that the new claims depend from independent claims 1, 7, 8 and 14. It has also been shown above that the independent claims are distinguishable over the cited references. Therefore, the new claims are also distinguishable over the cited references for at least the reasons stated with respect to the independent claims.

Moreover, the new claims are also distinguishable over the cited references on their own merit. For example, claim 21 recites in part "wherein the light which is incident through the image display portion is incident to the image display portion, from a display side, a part of the light being reflected by the semi-transparent film." This recitation clearly indicates the direction of the light whose portion is reflected by the semi-transparent film. Claims 23, 25, and 27 recite similar features.

In replies to previous Office Actions, Applicants argued that the light which is first incident upon a display passes through the display and is reflected back by the semi-transparent film. In response, the Examiner asserted that the statement is not what is claimed. The Examiner further asserted that the light that is being transmitted through the display as being the light that is passed through the semi-transparent film from the back light and separately an ambient light that the light that is reflected by the semi-transparent film. *See e.g., Final Office Action dated February 2, 2004, page 2, last paragraph.* The recitations of claims 21, 23, 25, and 27 squarely address this assertion, and none of the cited references teaches or suggests at least this feature.

Also, claims 22, 24, 26 and 28 recite in part “wherein the control device turns on the auxiliary lamp when it is determined that a completion signal ... is inputted thereto.” It is noted that none of the cited references teach or suggest this feature.

For at least the reasons stated above, the new claims are allowable over the cited references. Thus, Applicants respectfully request that the new claims 21-28 be allowed.

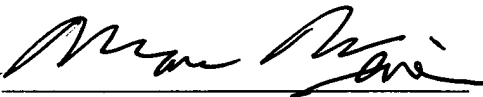
CONCLUSION

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By 

Marc S. Weiner
Reg. No. 32,181

HNS

MSW/HNS/jm
1982-0140P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000